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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,581	11/21/2003	Kurt K. Carbonero	0889.3029.002	3250

7590 01/10/2005

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EXAMINER

WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

10/719,581

Applicant(s)

CARBONERO, KURT K.

Examiner

Steven Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (3,858,876).

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 2-6 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (3,858,876) in view of Poegel, Jr. (D485,316). It would have been obvious to one of ordinary skill in the art to provide the ball of Williams with additional indicia as taught by Poegel, Jr. in order to provide additional teaching indicia on the ball of Williams.

Regarding claim 5 and 6, it would have been obvious to one of ordinary skill in the art to place a legend or instructions explaining the purpose of the indicia on the ball itself in order to permit the user to have easy access to the directions for use of the instructional ball of Williams as modified by Poegel, Jr.

Further, regarding claim 12, it would have been obvious to one of ordinary skill in the art to provide the ball of Williams as modified by Poegel, Jr. with indicia aligned with the middle finger instead of the index finger in order to have the user align himself with that finger.

5. Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (3,858,876) in view of Page et al. (6,722,889). The limitation for the indicia to indicate that the

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index finger is the last finger to contact the ball relates to the intended use of the indicia and is not considered a patentable difference from the indicia of Williams as modified by Page et al.

Response to Arguments

6. Applicant's arguments filed November 1, 2004 have been fully considered but are not deemed to be persuasive. The applicant contends that the reference to Williams does not teach indicia indicating that the person's palm should not touch the ball. However, this is not persuasive as Figure 6 is seen as indicating that a person's palm should not touch the ball. The applicant states that most of the drawing figures show the palm touching the ball. Specifically Figure 5 of Williams shows the outline of an entire hand indicating to the user the proper placement for their hand. Taken along the same line of reasoning, Figure 6 of Williams shows an outline of a hand where portions of the palm are missing. Clearly, this indicia is capable of indicating to the user that he should not place his palm on the ball. Further, it should be noted that the meaning for the indicia relates to the intended use and is not normally given patentable weight in an apparatus claim. Attention is directed to

Where it has been found that in order for the indicia to receive patentable weight a new and unobvious relationship between the indicia and the substrate must exist. In the instant case, this relationship fails to exist as the instant indicia may be placed on any size ball and any type of ball.

The applicant also argues that the rejection does not make sense to him. It is unclear to the examiner how the applicant can not understand that a depiction of the entire outline of a hand as shown in Figure 5 would indicate to the user to place his entire hand on the ball and a partial depiction of the outline of a hand would indicate to the user that he should only be placing those

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parts of the hand on the ball. The applicant's argument that this is physically impossible is without merit as he fails to present any evidence as to this assertion and it appears to be based solely on subjective opinion.

Regarding the rejection of claim 9, the applicant contends that the citation to *Breslow* is not pertinent since it dealt with indicia that was not precise. However, this is not persuasive as the fact situation to *Breslow* are pertinent to the instant case and lacking any showing of a new and unobvious relationship between the indicia and the substrate, any differences between the indicia of the instant invention and that taught by Williams are not considered to be patentable differences.

Regarding the rejection of claims 2-4 and 10-12, the reference to Poegel, Jr. is applied merely for the teaching that it is well known in the art of game balls and particularly basketballs to provide indicia on the surface of the balls for indicating the proper hand positioning on the ball. Both Poegel, Jr. and Williams provide outlines of hands for indicating that proper placement. Further, Poegel, Jr. emphasizes the user's hand placement by providing additional indicia on the ball. This additional indicia is obviously capable of indicating to the user that he should release the ball with the three middle fingers and also that one of those fingers should be the last finger touching the ball at the end of the release. It should have been clear to applicant that it was considered to have been obvious to one of ordinary skill in the art to provide the indicia of Poegel, Jr. on the surface of the ball of Williams in order to provide additional teaching indicia for the user. As stated above, the meaning of the indicia relates to its intended use and such meanings are not normally accorded patentable weight unless the applicant can demonstrate a new and unobvious relationship between the substrate and the indicia itself.

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Regarding claims 5 and 6, it has been considered to be obvious to one of ordinary skill in the art to provide a legend or instructions explaining the significance of the indicia on the ball in order to allow the user easily read the instructions for the ball.

Regarding claim 12, as stated above, the meaning of the indicia (that the middle finger is the last finger to contact the ball) relates to its intended use and such meanings are not normally accorded patentable weight. Even if the indicia were accorded patentable weight, it would have been obvious to one of ordinary skill in the art to provide the ball of Williams as modified by Poegel, Jr. with indicia aligned with the middle finger instead of the index finger in order to have the user align himself with that finger.

The applicant is also directed to the following case law citations that are pertinent to the instant application and the statement by the examiner that the intended use of the instant printed matter does not merit patentable weight lacking a showing of a new and unobvious relationship between the indicia and substrate. *In re Gulack* 217 USPQ 401; *In re Reeves* 20 CCPA 767, 62 F. 2d 199; *In re Russell* 18 CCPA 1184, 48 F.2d 668; *In re Sterling* 21 CCPA 1134, 70 F. 2d 910.

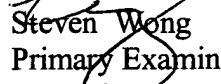
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven Wong
Primary Examiner
Art Unit 3711

SBW
January 7, 2005